

The opinion in support of the decision being entered today was *not* written for publication is *not* binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

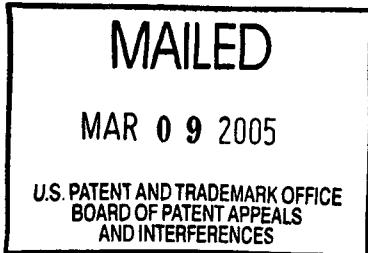
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES PRESCOTT CURRY

Appeal No. 2005-0509
Application 09/449,237

DECISION ON PETITION

On February 7, 2005, appellant filed a paper entitled "Petition under 37 C.F.R. §1.183 to Suspend the "Separate Paper Requirement" Under 37 C.F.R. §41.47(b) in a Request for Oral Hearing" (Paper No. 30). The instant petition has a certificate of mailing dated February 2, 2005. This petition is in response to the Notification of Non-Compliance Regarding Oral Hearing mailed January 19, 2005 (Paper No. 29). The basis of the Petition is that counsel believed that the filing of a transmittal sheet with the Appeal Brief constitutes a separate paper within the meaning of 37 CFR § 1.194, now rewritten as 37 CFR §41.47.



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On October 6, 2003, appellant filed two papers entitled "Appeal Brief (37 C.F.R. § 1.192)" and "Transmittal of Appeal Brief" (Papers Nos. 23 and 24). Appellant argues that the Transmittal of Appeal Brief (Paper No. 24), constitutes a separate paper under 37 CFR § 1.194. However, the Transmittal of Appeal Brief, does not contain a written request as required by 37 CFR § 1.194, which states:

- (a) An oral hearing should be requested only in those circumstances in which appellant considers such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided without an oral hearing will receive the same consideration by the Board of Patent Appeals and Interferences as appeals decided after oral hearing.
- (b) If appellant desires an oral hearing, appellant must file, in a separate paper, a written request for such hearing accompanied by the fee set forth in § 1.17(d) within two months from the date of the examiner 's answer. If appellant requests an oral hearing and submits therewith the fee set forth in § 1.17(d), an oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board. See § 1.136(b) for extensions of time for requesting an oral hearing in a patent application and § 1.550(c) for extensions of time for requesting an oral hearing in a reexamination proceeding.
- (c) If no request and fee for oral hearing have been timely filed by appellant, the appeal will be assigned for consideration and decision. If appellant has requested an oral hearing and has submitted the fee set forth in § 1.17(d), a day of hearing will be set, and due notice thereof given to appellant and to the primary examiner. A hearing will be held as stated in the notice, and oral argument will be limited to twenty minutes for appellant and fifteen minutes for the primary examiner unless otherwise ordered before the hearing begins.

If the Board decides that a hearing is not necessary, the Board will so notify appellant.

As can be seen by 37 CFR § 1.194(b), appellant must file, in a "separate paper, a written request for such hearing," as well as the fee. The pertinent part of the Transmittal of Appeal Brief of October 8, 2003 reads: "The total fee due is \$1,050.00 (appeal brief fee, fee for request for oral hearing, plus extension of fee, if any)." This does not constitute a written request within the meaning of 37 CFR § 1.194, the rule in effect at the time.

In addition, appellant has failed to set forth any extraordinary situation that may be remedied by a petition under 37 CFR § 1.183. 37 CFR § 1.183 states:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed.

Appellant argues that rule 37 CFR §41.47(b) which adds more significant requirements, needs to be waived. However, since appellant's submission failed to meet the written request requirement of 37 CFR §1.194, no extraordinary situation exists.

With regard to oral hearings, in accordance with 37 CFR § 1.194(a), it states that:

An oral hearing should be requested only in those circumstances in which appellant considers such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided without an oral hearing will receive the same consideration by the Board of Patent Appeals and Interferences as appeals decided after oral hearing.

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Thus, there is no occurrence of the client being severely prejudiced since an appeal receives the same consideration whether or not there was an oral hearing held.

Accordingly, the Petition is hereby DISMISSED without prejudice for applicant to consider a resubmission in compliance with 37 CFR § 1.183.

BOARD OF PATENT APPEALS
AND INTERFERENCES



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